

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 36

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte JOHN MUSACCHIA

Appeal No. 2004-0430
Application No. 09/174,868

ON BRIEF

Before COHEN, STAAB, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 and 3 to 18, which are all of the claims pending in this application.

We REVERSE and REMAND.

BACKGROUND

The appellant's invention relates generally to a hunting device for calling game. Particularly, the appellant's invention relates to an improved game call device of unitary construction having a game call portion and a platform portion. The game call portion is that portion of the appellant's invention that produces the calling sounds. Further, the appellant's game call can be retained securely relative to a hunter's body, and is elevated from the hunter's body by the platform portion. Thus, the hunter has instant, ready access to the appellant's call when secured to the body while the field performance of the appellant's invention, having percussive or friction-generated type game call portions, is not compromised (specification, p. 1). A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Musacchia

5,607,091

Mar. 4, 1997

Claims 1 and 3 to 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Musacchia.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the final rejection (Paper No. 24, mailed September 24, 2002) and the answer (Paper No. 30, mailed April 29, 2003) for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 27, filed March 24, 2003) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art reference, and to the respective positions articulated by the appellant and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 and 3 to 18 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is

established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention.

See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. See In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316-17 (Fed. Cir. 2000).

In the rejection under 35 U.S.C. § 103 before us in this appeal (final rejection, pp. 2-5), the examiner (1) set forth the pertinent teachings of Musacchia's hunting device for producing sound; (2) ascertained that "Musacchia discloses the claimed invention except for the game call device constructed as one piece as recited in claims 1, 10, 14 and 17" (the independent claims on appeal); and (3) concluded that:

It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the game call device as one piece, since it has been held that forming in one piece an article which has been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

The examiner has incorrectly drawn from the above-noted case law, which turned on specific facts, a general obviousness rule: namely, that forming several pieces integrally as a one-piece structure would have been obvious at the time the

invention was made to a person of ordinary skill in the art. No such per se rule exists.¹ See In re Hubbell, 164 F.2d 700, 702-04 76 USPQ 105, 107-09 (CCPA 1947); In re Otto, 121 F.2d 553, 555, 50 USPQ 149, 150 (CCPA 1941). The examiner's citation of Howard or any other case as a basis for rejecting claims that differ from the prior art by reciting a one-piece structure is improper, if it sidesteps the fact-intensive inquiry mandated by 35 U.S.C. § 103. Thus, in this case, one must determine if it would have been obvious to one of ordinary skill in the art at the time the invention was made to make Musacchia's separate call and platform as a one-piece structure.

In this case, we agree with the appellant that the examiner has failed to establish a prima facie case of obviousness for the claims under appeal with respect to the one-piece limitation as recited in claims 1, 10, 14 and 17. In that regard, it is our determination that there is no evidence before us in this appeal that the one-piece

¹ In Howard the Supreme Court stated (150 U.S. at 169-70) that the Monumental grate, which was in public use five years before application was made for the patent under consideration, contains all of the elements of the Beckwith grate, except that, being adapted for burning coal, it is cast in two pieces, while the Beckwith grate is cast in one piece. This does not involve patentable invention.

. . . As to the third patent, it is void because the claims in it were clearly anticipated, and because it involves no invention to cast in one piece an article which has formerly been cast in two pieces, and put together.

In Howard, prior art other the Monumental grate taught casting the grate in one piece. Thus, providing evidence as to why it would have been obvious at the time Beckwith's invention was made to a person of ordinary skill in the art to have cast the Monumental grate as one piece.

limitation would have been obvious to one of ordinary skill in the art at the time the invention was made from the teachings of Musacchia.

For the reasons set forth above, we conclude that the examiner's determination of the obviousness of the one-piece limitation has not been supported by any evidence² that would have led an artisan to arrive at the claimed invention. In our view, the only suggestion for modifying Musacchia in the manner proposed by the examiner in the rejection before us in this appeal to meet the one piece limitation stems from hindsight knowledge derived from the appellant's own disclosure. The use of such hindsight knowledge to support an obviousness rejection under 35 U.S.C. § 103 is, of course, impermissible. See, for example, W. L. Gore and Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

² Evidence of a suggestion, teaching, or motivation to modify a reference may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), Para-Ordinance Mfg., Inc. v. SGS Importers Int'l., Inc., 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), cert. denied, 117 S. Ct. 80 (1996), although "the suggestion more often comes from the teachings of the pertinent references," In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). The range of sources available, however, does not diminish the requirement for actual evidence. A broad conclusory statement regarding the obviousness of modifying a reference, standing alone, is not "evidence." Thus, when an examiner relies on general knowledge to negate patentability (such as making plural elements into a single-piece assembly), that knowledge must be articulated and placed on the record. See In re Lee, 277 F.3d 1338, 1342-45, 61 USPQ2d 1430, 1433-35 (Fed. Cir. 2002) and In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

For the reasons set forth above, we are constrained to reverse the decision of the examiner to reject independent claims 1, 10, 14 and 17, and claims 3 to 9, 11 to 13, 15, 16, 17 and 18 dependent thereon, under 35 U.S.C. § 103.

REMAND

We remand this application to the examiner for further consideration of the patentability of claims 1 and 3 to 18. Specifically, we remand this application to the examiner to ascertain if there is any prior art evidence establishing that it would have been obvious at the time the invention was made to a person of ordinary skill in the art to have modified Musacchia's hunting device to arrive at the claimed invention.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 and 3 to 18 under 35 U.S.C. § 103 is reversed. In addition, we have remanded this application to the examiner for further consideration.

This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01.

REVERSED and REMANDED

IRWIN CHARLES COHEN
Administrative Patent Judge

LAWRENCE J. STAAB
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

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